

PATENT
USSN 10/044,539
Docket 002630US; 018/212c

REMARKS

This paper is responsive to the Office Action dated July 29, 2004, which is the first action on the merits of the application.

Claims 1-38 were previously pending in the application, and under examination. Upon entry of this paper, claim 1 is amended, claims 39-40 are added, and claims 34-35 have been cancelled without prejudice. Accordingly, claims 1-33 and 36-40 are now pending in the application and under examination.

Further consideration and allowance of the application is respectfully requested.

Interview Summary:

The undersigned wishes to express his gratitude to Examiner Louis D. Lieto and Examiner Ann Marie Whebe for the helpful and constructive interview held at the Patent Office on September 2, 2004. Possible amendments to the claims and a terminal disclaimer were discussed. This paper incorporates amendments and remarks presented during the interview.

Priority:

The priority information in paragraph [0001] of the published application has been amended as requested in the Office Action. The first priority date is now April 18, 1997, which means that the patent issuing on this application will have a term extending to April 18, 2017, subject to any terminal disclaimer, patent term extension, or patent term adjustment.

The Office Action indicates that the specific cell types referred to in claims 6-36 are not supported by priority applications filed before August 14, 1997. Nevertheless, the skilled reader will understand that the cell types referred to in claims 6-36 are specific species of the mammalian cells of claims 1-5 and 39-40, and that the practice of claims 6-36 will also entail practice of generic claims with their respective priority entitlements.

Rejections under 35 USC § 112:

Claim 1 and its dependents are rejected under § 112 ¶ 1 as not enabled by the specification for fragments and variants of SEQ. ID NO:1 as broadly claimed. Claim 1 is also rejected under § 112 ¶ 2 as indefinite for recitation of stringent hybridization conditions.

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Applicants respectfully disagree. The specification explicitly defines stringent hybridization conditions in paragraph [0466] of the application as filed. The skilled reader will know how to make variants that hybridize to the prototype sequence (SEQ. ID NO:1) under these conditions. Candidate variants can be tested for telomerase activity using several assays described in the specification in detail. See, for example, the section starting at paragraph [0127].

To facilitate prosecution of the application, conditions listed in paragraph [0466] have now been added to the claim. Since the added language merely states explicitly what was previously inherent, coverage for equivalent conditions and equivalent polynucleotides is retained.

Applicants understand that this wording is acceptable to the Examiners. Withdrawal of these rejections is respectfully requested.

The rejection of claims 34-35 under § 112 ¶ 1 need not be addressed, since these claims have been cancelled.

Double patenting:

Claims 1-38 are rejected in the Office Action for obviousness-type double patenting over claims 1-8 of U.S. Patent No. 6,475,789.

This application is commonly owned with the '789 patent. Enclosed herewith is a Terminal Disclaimer with respect to the '789 patent. Withdrawal of this rejection is respectfully requested.

Under 37 CFR § 1.56, applicants wish to bring to the attention of the Examiner the other issued and pending applications in this series relating to the hTRT sequence.

- The issued patents for hTRT are U.S. 6,475,789, which the Examiner has already considered; U.S. 6,261,836; and U.S. 6,617,110. Copies of the issued claims accompany this Amendment.
- The allowed applications for hTRT are USSN 09/438,486; 09/766,253; 09/843,676; and 10/054,295. Copies of the allowed claims accompany this Amendment.
- The other pending applications for hTRT are USSN 08/974,584; 09/432,503; 09/721,477; 09/721,506; 10/053,758; 10/054,611; 10/044,692; 10/877,022; 10/877,128; and 10/877,146.
- Patents claiming TRT from single celled ciliates are U.S. 6,093,809; U.S. 6,166,178; and U.S. 6,309,867.

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- Patents and patent applications for mouse TRT are U.S. 6,767,719 and USSN 10/862,698.
- Patents and applications for the hTRT promoter are U.S. 6,610,839; U.S. 6,777,203; USSN 10/325,810; and USSN 10/674,836.
- Patents and applications for hTRT variants are U.S. 6,337,200 and USSN 09/990,080.
- Patents and applications for hTRT antisense oligonucleotides are U.S. 6,444,650; U.S. 6,627,619; and USSN 10/637,443.

Applicants are not aware of any double patenting issue, other than what was raised in the Office Action. However, the Examiner is invited to do his own assessment.

Information disclosure statement

An information disclosure statement was filed with this application on January 11, 2002. However, applicants have not yet received an initialed PTO-1449, indicating that the information has been considered and made of record in this application.

The Examiner is respectfully requested to acknowledge that the information has been considered. A copy of the PTO-1449 is enclosed for his convenience.

Request for Interview

Applicants respectfully request that all outstanding rejections be reconsidered and withdrawn. The application is believed to be in condition for allowance, and a prompt Notice of Allowance is requested.

In the event that the Examiner determines that there are other matters to be addressed, the undersigned hereby requests a further interview by telephone.

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Fees Due

No fee is required with respect to the amendments to the claims, since the claim count has not changed. Enclosed with this Amendment is authorization to charge the Deposit Account for the Terminal Disclaimer fee.

Should the Patent Office determine that an extension of time or any other relief is required for further consideration of this application, applicants hereby petition for such relief, and authorize the Commissioner to charge the cost of such petitions and other fees due in connection with the filing of these papers to Deposit Account No. 07-1139, referencing the docket number indicated above.

Respectfully submitted,

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September 21, 2004

Enclosures:

- Terminal Disclaimer over U.S. Patent No. 6,475,789
- Cover and claims from U.S. Patent Nos. 6,261,836 and 6,617,110
- Allowed claims from USSN 09/438,486; 09/766,253; 09/843,676; and 10/054,295
- Copy of PTO-1449 from IDS filed January 11, 2002
- Fee Calculation Sheet & Transmittal

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